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**JAN 29 2004**

**OFFICE OF PETITIONS**

In re Application of

Booth

Application No. 09/819,033

Filed: 23 August, 2000

Attorney Docket No. (None)

ON PETITION

This is a decision on the petition filed on 22 December, 2003, to revive the above-identified application under 37 C.F.R. §1.137(a)

For the reasons set forth below, the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

**NOTES:**

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b) (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";
- (2) Thereafter, there will be no further reconsideration of this matter.
- (3) Petitioner's submissions suggest a lack of familiarity with practice before the Office. Petitioner may wish to seek the guidance of an individual registered to practice before the Office, which information may be found at [www.uspto.gov](http://www.uspto.gov).

### BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 23 May, 2003, with a reply due (absent a request and fee for extension of time) on or before Monday, 25 August, 2003;
- as a result, the application was deemed abandoned after midnight 23 August, 2003;
- Notice of Abandonment was mailed on 17 December, 2003;
- Petitioner alleges severe illness in October 2003 was the cause of the abandonment—but presents no documentary evidence in support of the allegation;
- moreover, the shortened statutory period elapsed before Petitioner indicates the onset of his illness;
- contemporaneously with the petition, Petitioner submits a document:
  - in which he describes his delay as unintentional, rather than unavoidable; and
  - which, while it may be intended as a reply to the 23 May, 2003, Office action, does not appear to be in conformance with Office practice (see: MPEP §714).
- as indicated, a reply was filed with the instant petition, however, Petitioner may find that it is not sufficient.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup> Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup>

And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

Petitioner has failed to: make a showing of unavoidable delay, and, in fact, has indicated that his delay was unintentional.

Accordingly, in view of the record, the petition as considered under 37 C.F.R. §1.137(a) hereby is **dismissed** for failing to satisfy the “showing” requirement. Further, Petitioner is reminded that his reply may not satisfy the “reply” requirement.

#### ALTERNATIVE VENUE

If Petitioner is unable to make a showing of unavoidable delay surpassing that tendered heretofore, Petitioner's only alternative to irretrievable abandonment likely is to file a petition and

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<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared and/or deposited for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely prepared and/or deposited for shipment.

fee as set forth at NOTE 1, above at page 1, under 37 C.F.R. §1.137(b), and state therein that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition (with fee) pursuant to 37 C.F.R. §1.137(b) was unintentional.”

Thus, Petitioner may wish to supplement his petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the “showing ” burden is much less onerous.

A copy of the form for this petition is enclosed herewith.

Petitioner is cautioned that failure to submit such a petition 37 C.F.R. §1.137(b) timely may be viewed as intentional delay and an absolute bar to revival.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)<sup>7</sup>  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (703) 872-9306  
ATTN.: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

Encl: Form: Petition for revival alleging unintentional delay

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<sup>7</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).